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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/743,713   | 12/24/2003  | Hiroshi Kamikawa     | Q79192              | 8326             |
| 23373  | 7590        | 04/04/2006           | EXAMINER            |                  |
| <b>SUGHRUE MION, PLLC</b><br>2100 PENNSYLVANIA AVENUE, N.W.<br>SUITE 800<br>WASHINGTON, DC 20037 |             |                      |                     | HESS, BRUCE H    |
|  |             | ART UNIT             |                     | PAPER NUMBER     |
|  |             | 1774                 |                     |                  |

DATE MAILED: 04/04/2006

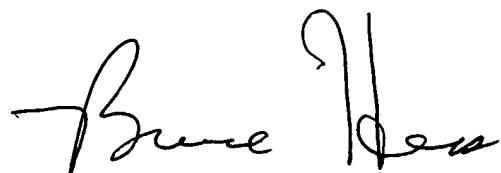
Please find below and/or attached an Office communication concerning this application or proceeding.

|  |                           |  |  |
|--|---------------------------|--|--|
| <b>Office Action Summary</b>   | Application No.           | Applicant(s)   |  |
|  | 10/743,713                | KAMIKAWA, HIROSHI  |  |
|  | Examiner<br>Bruce H. Hess | Art Unit<br>1774   |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>   |                           |  |  |
| <b>Period for Reply</b>  |                           |  |  |
| <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> </ul> <p>Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p> |                           |  |  |
| <b>Status</b>  |                           |  |  |
| <p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>3-14-06 (Amendment)</u></p> <p>2a)<input type="checkbox"/> This action is FINAL.                  2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>  |                           |  |  |
| <b>Disposition of Claims</b>   |                           |  |  |
| <p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>   |                           |  |  |
| <b>Application Papers</b>  |                           |  |  |
| <p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p style="margin-left: 20px;">Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11)<input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p>   |                           |  |  |
| <b>Priority under 35 U.S.C. § 119</b>  |                           |  |  |
| <p>12)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All    b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p>1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>  |                           |  |  |
| <p>* See the attached detailed Office action for a list of the certified copies not received.</p>  |                           |  |  |
| <b>Attachment(s)</b>   |                           |  |  |
| <p>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO-95/08)<br/>Paper No(s)/Mail Date <u>3-14-06 10/18/06</u></p>   |                           | <p>4)<input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date _____</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____</p> |  |

Art Unit: 1774

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the patents to Katsuya et al. (JP 05-156421 or JP 2000-233574).

These patents both teach heat-sensitive recording material which employ a mixture of different microcapsules. Since the microcapsules are different, it appears that the microcapsules have different particle diameters (see the newly submitted action by the Japanese Patent Office). Applicant's 132 Declaration which establishes that unexpected results are obtained with a microcapsule mixture having different particle sizes and Tg's as compared to a microcapsule mixture having only different Tg's does not overcome the newly cited references whose microcapsules also appear to have different particle diameters and Tg's.



BRUCE H. HESS  
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